UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,767	04/11/2001	G. Mark McGregor	P00471-US-1 (17359.0003)	3380

26884   7590   12/01/2009
PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
1700 S. PATTERSON BLVD.
DAYTON, OH 45479-0001

EXAMINER
CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
12/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 July 2009_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _14-25 and 27_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _14-25 and 27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102 and 35 USC § 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
   basis for the rejections under this section made in this Office action:

   > A person shall be entitled to a patent unless –
   >
   > (e) the invention was described in (1) an application for patent, published under section 122(b), by
   > another filed in the United States before the invention by the applicant for patent or (2) a patent
   > granted on an application for patent by another filed in the United States before the invention by the
   > applicant for patent, except that an international application filed under the treaty defined in section
   > 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
   > only if the international application designated the United States and was published under Article 21(2)
   > of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness
   rejections set forth in this Office action:

   > (a) A patent may not be obtained though the invention is not identically disclosed or described as set
   > forth in section 102 of this title, if the differences between the subject matter sought to be patented and
   > the prior art are such that the subject matter as a whole would have been obvious at the time the
   > invention was made to a person having ordinary skill in the art to which said subject matter pertains.
   > Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Capiel
   (US006449634B1).

4. Capiel teaches (independent claim 14) a method for advertising/generating revenue by
   sending email messages appended with advertising, comprising (as recited by claim 14) the
   steps of:

   transmitting an e-mail message (Fig. 3 and col. 43 lines 52-60) addressed to at least one
   email recipient (*E-mail client 142*) from a first client computer (e.g., *vendor system A 112*,
   Fig. 1 and col. 3 lines 11-21) to a host server (*E-mail sensor sever 130*) through at least one
   computer network (*Internet 140*), wherein the e-mail message comprises an e-mail address
   of an e-mail user (col. 5 line 53), an e-mail address of the at least one e-mail recipient (col. 5
   line 55), a subject (col. 5 line 57), and a body (col. 6 lines 1-55);

   appending advertisement retrieval software means (*HTML image tag 316*, Fig. 3 and col.
   4 lines 52-60, col. 7 lines 34-46 and col. 6 lines 55-60) to the e-mail message transmitted
   from the first client computer, wherein the advertisement retrieval software means comprises

information about at least one of a plurality of advertisements (*vendor's own HTML documents*, col. 3 lines 22-42 and Fig. 1) retrievably stored in a database (*E-mail sensor database 132*);

transmitting (col. 4 lines 64 to col. 5 line 2) the e-mail message from the host server to a second client computer (*the E-mail client*, e.g., *Email client 142* in Fig. 1) through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and

displaying (col. 5 lines 2-9) the e-mail message (e.g., Fig. 3A and col. 6 lines 1-55) on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means (*the HTML image tag 316*) is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database (either the plain text *312* or the *HTML text 314* versions of the ad, col. 4 lines 52-64, col. 5 lines 6-9 and col. 6 line 63 to col. 7 line 33) for display with the e-mail message on the second client computer.

5. <u>Capiel also teaches</u>: claim 15 (col. 3 lines 22-42, where the user's email address and whether or not the user can read HTML text reads on "profile information" and "target characteristics").

6. <u>Claim 16</u> is rejected under 35 U.S.C. 103(a) as being unpatentable over Capiel (US006449634B1) in view of Conley, Jr., et al. (US006434745B1, hereafter "Conley"). <u>Capiel does not teach</u> parsing the subject and body of the e-mail message to identify keywords which may be present therein. <u>Conley teaches</u> searching email messages for keywords to target advertising (col. 2 line 61 to col. 3 line 4 and col. 1 lines 42-46), which reads on parsing the subject and body of the e-mail message to identify keywords which may be present therein. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Capiel teaches that ad targeting is important for email sales (col. 1 lines 22-26). Conley teaches that searching the email itself for keywords can improve ad targeting.

7. <u>Claims 14, 15, 17-19, 21-25 and 27</u> are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US006836792B1) in view of Capiel (US006449634B1).

8. <u>Chen teaches</u> (independent claim 14, 18 and 21 and dependent claims 22 and 23) a method
for advertising/generating revenue by sending email messages appended with advertising,
comprising (as recited by claim 14) the steps of:

transmitting an e-mail message (*send emails*, col. 6 lines 33-38 and Fig. 3) addressed to
at least one *email recipient 106* from a first client computer *108* (Fig. 3 and col. 1 lines 45-
51) to a host *server 304* (col. 6 lines 59-63) through at least one computer network, wherein
the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the
at least one e-mail recipient, a subject, and a body (col. 1 lines 27-33);

appending an advertisement (col. 8 lines 19-26) to the e-mail message transmitted from
the first client computer, wherein the advertisement comprises information about at least
one of a plurality of advertisements (col. 7 lines 57-64) retrievably stored in a *database of
advertisement inserts 340* (col. 8 lines 19-26);

transmitting the e-mail message from the host server to a second client computer *150*
(Fig. 3) through the at least one computer network based upon the e-mail address of the at
least one e-mail recipient (col. 8 line 61 to col. 9 line 5); and

displaying the e-mail message on the second client computer (col. 2 lines 21-29).

9. <u>Chen does not teach</u> appending <u>advertisement retrieval software means</u> to the e-mail
message, wherein <u>when the e-mail message is first displayed</u> on the second client computer
<u>the advertisement retrieval means is operable</u> at the second client computer <u>to retrieve at
least one of the advertisements retrievably stored in the database for display with the e-mail
message</u> on the second client computer. <u>Capiel teaches</u> appending advertisement retrieval
software means (*HTML image tag 316*, Fig. 3 and col. 4 lines 52-60, col. 7 lines 34-46 and
col. 6 lines 55-60) to the e-mail message, wherein when the e-mail message is first
displayed on the second client computer the advertisement retrieval means is operable at
the second client computer to retrieve at least one of the advertisements (*vendor's own
HTML documents*, col. 3 lines 22-42 and Fig. 1) retrievably stored in a database (*E-mail
sensor database 132*) for display with the e-mail message on the second client computer.

10. <u>Because Capiel teaches</u> three advantages for appending advertisement retrieval software
means to an email message, it would have been obvious to one of ordinary skill in the art, at
the time of the invention, to add the teachings of Capiel to those of Chen. In addition, under

KSR v. Teleflex (82 USPQ 2nd 1385), the combination would be obvious because it is a simple substitution of one known element for another to obtain predictable results. Capiel teaches advertisement retrieval software that can be readily substituted for the inserted advertisement taught by Chen. Furthermore, Capiel teaches that the insertion of advertisement retrieval software can make email marketing more effective (col. 1 lines 40-41 and 52-65).

11. For claim 18, Chen teaches *payment … to the email system operator* (col. 2 lines 56-60), which reads on "contribution" to "an entity selected by an e-mail user". For claim 21, Chen also teaches "accounting for advertising revenue (*payment*, col. 2 lines 56-60) and "transmitting a return communication (col. 2 line 61 to col. 3 line 3). Also for claim 21, *HTML image tag 316* reads on "a sub-message associated with an advertisement … based upon preferences of the user" (the user would prefer to send or receive whichever of *plain text 312* or *HTML 314*, col. 4 lines 52-60, that they can best read).

12. Chen also teaches at the citations given above claims 17 and 27.

13. Chen also teaches claims 15, 19, 24 and 25 (col. 6 lines 14-18 and col. 7 line 64 to col. 8 line 14).

14. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US006836792B1) in view of Capiel (US006449634B1), and further in view of Conley, Jr., et al. (US006434745B1, hereafter "Conley").

15. Neither Chen nor Capiel teach parsing the subject and body of the e-mail message to identify keywords which may be present therein. Conley teaches searching email messages for keywords to target advertising (col. 2 line 61 to col. 3 line 4 and col. 1 lines 42-46), which reads on parsing the subject and body of the e-mail message to identify keywords which may be present therein. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Chen teaches using ad targeting as a means to support the use of email and Capiel teaches that ad targeting is important for email sales (col. 1 lines 22-26). Conley teaches that searching the email itself for keywords can improve ad targeting.

Response to Arguments

16. Applicant's arguments filed with an amendment on 14 July 2009 have been fully considered. Except as noted below, the arguments are moot in view of the new bases of rejection.

17. <u>Applicant argues</u>,

"Chen further fails to disclose appending a sub-message associated with an advertisement based up[on] preferences of the e-mail user, i.e., the sender of the email. The teachings of Chen are focused on preferences of email recipients, not preferences of email senders." (Last full para. on p. 15, typographical error corrected)

First, the claims are limited to email <u>users</u>, not senders, and indeed the word "sender" does not appear to be even disclosed in the instant application. Second, the plain and widely accepted meaning of email "user" is both a sender and a recipient of email, and that indeed is disclosed in the instant application (first sentence of para. [0007] of the published application, US 20020026360A1). Third, since the applicant does not disclose a special "clear definition" for "email user", the law requires the examiner to give claim terms their plain meaning (MPEP § 2111.01). Chen (col. 6 lines 14-18) teaches selecting advertisements based on a *user profile*, which reads on "appending a sub-message associated with an advertisement based upon preferences of the e-mail user".

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

21. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

23. **AFTER FINAL INTERVIEW PRACTICE –** Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence in an interview request (form PTOL-413A) that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

24. Applicant may have after final arguments considered and amendments entered by filing an RCE.

25. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

28 November 2009   /Donald L. Champagne/
                                         Primary Examiner, Art Unit 3688